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Paper No. 9

JEFFREY S. WHITTLE, ESQUIRE
ALLEN, DYER, DOPPELT, MILBRATH & GILCHRIST, P.A.
255 S. ORANGE AVE., SUITE 1401
P.O. BOX 3791
ORLANDO, FL 32802-3791

COPY MAILED

APR 25 2001

**OFFICE OF PETITIONS
A/C PATENTS**

In re Application of
Haberland, Marchand, Nilson,
Hagen & Gladdish
Application No. 09/580,721
Filed: May 30, 2000
For: Trocar System Having Shielded
Trocar

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DECISION ON PETITION

This is in response to the petition to correct inventorship under 37 CFR 1.48(a), filed January 29, 2001.

This is also in response to the petition under 37 CFR 1.47(a), filed January 29, 2001.

The petition to correct inventorship is **dismissed as moot**.

The petition under 37 CFR 1.47(a) is **dismissed**.

Under 37 CFR 1.48(a)

Applicants petition to include Bennie W. Gladdish, Jr., as an inventor because he was inadvertently omitted from the original filing of the subject patent application. The Office notes that applicants did not submit an executed oath or declaration with the original application papers filed on May 30, 2000. Pursuant to 37 CFR 1.48(f)(1): "If the correct inventor or inventors are not named on filing a nonprovisional application under § 1.53(b) without an executed oath or declaration under § 1.63, the later submission of an executed oath or declaration under § 1.63 during the pendency of the application will act to correct the earlier identification of inventorship."

Accordingly, the executed declaration submitted with the present petition will act to correct the omission of Mr. Gladdish as an inventor. In view of the circumstances, the \$130.00 petition fee is unnecessary and will be credited to Deposit Account No. 01-0484.

Under 37 CFR 1.47(a)

Applicants are given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on May 30, 2000, without an executed oath or declaration. Accordingly, on August 16, 2000, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration, the statutory basic filing fee, and a surcharge for their late filing.

In response, on January 29, 2001, applicants filed the present petition, a request for a four (4) month extension of time, a Declaration and Power of Attorney, the requisite fees, and a Statement of Facts of Gary Haberland, a joint inventor. In the Statement of Facts, Mr. Haberland states a package containing a draft of the subject patent application and supporting documents, e.g., the Declaration and Power of Attorney and Assignments documents were sent to joint inventors, Messrs. Marchand and Hagen, by U.S. Mail on August 22, 2000. A copy of the cover letter to Mr. Haberland, and carbon copied to the other four joint inventors, from Jeffrey S. Whittle, the attorney of record, accompanies the petition. Mr. Haberland further states that on January 12, 2001, a second package containing a draft of the subject patent application, as well as supporting documents was sent to Mr. Marchand via UPS next day air service. A copy of the cover letter sent to Mr. Marchand from Mr. Haberland, as well as a copy of the UPS label accompanies the petition.

As evidence of Mr. Hagen's refusal to join in the application, Mr. Haberland asserts: "I tried on several occasions to set up an appointment with Mr. Robert Sean Hagen to review the subject patent application and acquire his signature on the supporting documents." *Statement of Facts, dated 01/24/01, p. 2.* "Mr. Hagen repeatedly put me off asking me to try another day or call back at a more convenient time." *Id.* As to Mr. Marchand's refusal, Mr. Haberland simply states that Mr. Marchand has refused to join in the application.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the nonsigning inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the nonsigning inventor. Applicants lack item (1) as set forth above.

As to item (1), applicants failed to demonstrate that the nonsigning inventor, Mr. Hagen, was presented with a complete copy of the application papers for review. Applicants submitted a cover letter address to Mr. Haberland, which was carbon copied to Mr. Hagen with enclosures.

However, applicants did not submit a copy of the cover letter to Mr. Hagen or indicate the enclosures sent to Mr. Hagen. Unless Mr. Hagen was presented with a copy of the application papers (specification, claims and drawings), Mr. Hagen could not attest that he has "reviewed and understands the application papers," and therefore, could not sign the declaration which he was given.

Additionally, applicants did not set forth a detailed account of the events that surrounded the refusal of Messrs. Hagen and Marchand to join in the application. Accordingly, applicants failed to show or provide proof that Messrs. Hagen and Marchand have refused to sign the declaration. Applicants should show that a copy of the application papers were presented to Messrs. Hagen and Marchand, but that they did not respond to the request that they sign the oath/declaration in order to prove that they have refused to join in the application. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events.

Section 409.03(d) of the Manual of Patent Examining Procedure states:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, Mr. Haberland does not specify the circumstances of the refusal of Messrs. Hagen and Marchand to join in the application. As to Mr. Hagen's refusal, it is unclear whether his request for Mr. Haberland to

call back at a more convenient time constitutes a refusal. Applicants should set forth the time period which the telephone calls were made, as well as the nature of the conversations.

As to Mr. Marchand's refusal, applicants fail to explain whether Mr. Marchand refused to join in the application or did not respond to their request to join in the application after a reasonable time from the mailing of the second package.

Accordingly, applicants have not met the requirements of 37 CFR 1.47(a), and thus, the petition must be dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA

Telephone inquiries related to this decision may be directed to Petitions Attorney Christina T. Tartera at (703) 306-5589.

A handwritten signature in black ink, appearing to read "B. Flanagan" followed by a stylized flourish and the word "for".

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy